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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,420	12/20/2001	Todd A. Schwartz	884.619US1	2690

21186 7590 09/29/2005

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EXAMINER

RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/027,420

Applicant(s)

SCHWARTZ ET AL.

Examiner

Rob Rhode

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 12-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 & 7-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Claims 6 and 12 – 24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and species with claim 8 considered to be Generic for Groups I and II. Applicant timely traversed the restriction (election) requirement in the reply filed on 7-20-05. The Applicant's arguments regarding claims 8 – 11 was persuasive and thereby claims 1 – 5 and 7 - 12 were examined.

The requirement is still deemed proper and is therefore made FINAL.

### ***Drawings***

The drawings filed on 12-20-01 are acceptable for initial examination. However, formal drawings will be required. In order to avoid abandonment of this application, correction is required in reply to the Office action.

The correction will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Applicant did not select the Species of claim 6, which for examination effectively withdrew the claim from consideration. In that regard, claim 7 is dependent from the withdrawn claim 6, which makes claim 7 indefinite.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

The claimed invention is directed to non-statutory subject matter. The claim is directed to an "memory capable of being communicatively couple with a sales computer, including a plurality of items, wherein....items is associated", which is considered to be non-functional descriptive material per se and is not

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considered statutory - because the non-functional descriptive material is not capable of causing functional change in the computer. Thereby, the claim does not define any structural interrelationships between the data structure (information) and other claimed aspects of the invention (see MPEP 2106). Moreover, the claims do not produce any concrete or tangible "results" and thereby are for this additional reason considered to be non statutory.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1 – 5 and 7 - 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Cansler (US 6,725,257 B1).**

Regarding claim 1 and related claim 8, Cansler teaches a digital content pricing system, comprising: a sales computer; a purchase computer capable of being communicatively coupled with the sales computer; and a memory capable of being communicatively coupled with the sales computer, including a plurality of digital content items, wherein each one of the plurality of digital content items is

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associated with a base price and at least one item configuration option associated with an option price, and wherein each one of the plurality of digital content items is associated with a final price related to the base price and the option price by a final pricing formula (see at least Abstract, Col 2, lines 41 – 67, Col 3, lines 1 – 3, Col 7, lines 14 – 19 and Figures 1 – 6). Please note that the phrase “digital content” in the preamble was given very little patentable weight in light of the fact that this phrase connotes intended use and thereby does not limit the apparatus and system to just “digital content”. In addition, computer apparatus and system including memory store, which includes stored data such as “digital content” and associated/linked data is considered to be non-functional descriptive material and thereby too is given very little patentable weight (MPEP 2106). In online systems for identifying, selecting and configuring an items/product that a kind/type including such specifics of the product as “digital content” or features such as “option” as well linked/associated data of an item/product is given little patentable weight. The phrase(s) and or word(s) are given little patentable weight because the claim language limitation is considered to be non-functional descriptive material, which does not patentably distinguish the applicant’s invention from Cansler. Thereby, the non-fictional descriptive material is directed only to the content of the data (. i.e. digital content and linked data/information - which is stored data/information) and does not affect the structure of Cansler, which leaves the system unchanged. Therefore and for examination purposes the claims 1 and 8 were considered to be - A pricing system, comprising: a sales computer; a purchase computer capable of being

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communicatively coupled with the sales computer; and a memory capable of being communicatively coupled with the sales computer, including a plurality of items/products.

Regarding claim 2, Cansler teaches a digital content pricing apparatus, wherein at least one of the plurality of digital content items is directly associated with the final pricing formula (see above rejection regarding non-functional descriptive material).

Regarding claim 3, Cansler teaches a digital content pricing apparatus, wherein the memory includes a plurality of pricing formulae including the final pricing formula (see above rejection regarding non-functional descriptive material).

Regarding claim 4, Cansler teaches a digital content pricing apparatus of claim 1, wherein at least one of the plurality of digital content items is associated with a plurality of configuration options, including the item configuration option (see above rejection regarding non-functional descriptive material).

Regarding claim 5, Cansler teaches a digital content pricing apparatus, wherein the final pricing formula includes an option adjustment factor associated with the item configuration option (see above rejection regarding non-functional descriptive material).

Regarding claim 7, Cansler teaches a digital content pricing apparatus, wherein the at least one selected external factor is determined by a type of selected ones

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of the plurality of digital content items, a quantity of each type of the selected ones of the plurality of digital content items, the base price, and the option price. The Examiner takes Official Notice that the ability to select a plurality of items, which obviously would include quantity of different types would include a base price and option price in purchasing of cars for example. In this manner, the system will potentially increase revenue and profits as result of providing the ability to purchase multiple items.

Regarding claim 9, Cansler teaches a digital content pricing system, further comprising: an item selection device capable of being communicatively coupled to the purchase computer (Figures 1 and 2).

Regarding claim 10, Cansler teaches a digital content pricing system, wherein at least one of the plurality of digital content items is directly associated with the final pricing formula (see above rejection regarding non-functional descriptive material).

Regarding claim 11, Cansler teaches a digital content pricing system, wherein the final pricing formula includes an option adjustment factor associated with the item configuration option (see above rejection regarding non-functional descriptive material).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is



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**571.272.6761.** The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **571.272.7159**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

**Alexandria, Va. 22313-1450**

or faxed to:

**571-273-8300**

[Official communications; including

After Final communications labeled

"Box AF"]

For general questions the receptionist can be reached

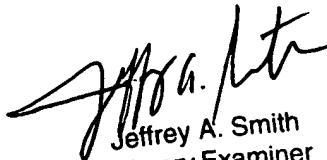
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Jeffrey A. Smith  
Primary Examiner